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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/207, 161 12/07/98 HILLMAN

J PF-0208US

HM12/0119

EXAMINER

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CARLSON, K

ART UNIT	PAPER NUMBER
	6

1653

DATE MAILED:

01/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/207,161	Applicant(s) Hillman et al.
	Examiner Karen Cochrane Carlson	Group Art Unit 1653
		

Responsive to communication(s) filed on Dec 7, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claim

Claim(s) 1 and 11-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1 and 11-18 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claims 2-10 have been canceled. Claims 1 and 11-18 are currently pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 5 I. Claims 1 and 11, drawn to integral membrane protein, classified in class 530, subclass 350.
- II. Claim 12, drawn to antibody against integral membrane protein, classified in class 530, subclass 387.1.
- 10 III. Claim 13, drawn to agonist of integral membrane protein, classified in class 530, subclass 350.
- IV. Claims 14 and 15, drawn to antagonist of integral membrane protein, classified in class 530, subclass 350.
- V. Claim 16, drawn to method of treatment with the agonist of integral membrane protein, classified in class 514, subclass 12.
- 15 VI. Claims 17 and 18, drawn to a method of detecting polynucleotides encoding integral membrane protein via hybridization, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

20 The proteins of Invention I are related to the antibodies of Invention II by virtue of being the cognate antigen, necessary for the production of antibodies. Although the protein and antibody are related due to the necessary stearic complementarity of the two, they are distinct Inventions because the protein can be used in another and materially different process from the use for the production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein (if the protein is itself a receptor), or in assays for the identification of agonists or antagonists of the receptor protein.

The protein of Invention I and the agonist of Invention III are related in that both products have similar activities. However, the structure of the products are different and therefore these Inventions are patentably distinct.

5 The protein of Invention I and the antagonist of Invention IV have differing structure and opposing function. Therefore, these products are patentably distinct.

The protein of Invention I is not used in either of the methods of Inventions V or VI. Therefore, Invention I is patentably distinct from Inventions V and VI.

10 The antibody of Invention II, the agonist of Invention III, and the antagonist of Invention IV differ in structure and function one from the other. Therefore, Inventions II, III, and IV are patentably distinct from each other.

15 Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as in binding assays, for example.

20 The agonist of Invention III is not used in either of the method of Invention VI. Therefore, Invention II is patentably distinct from Inventions VI.

25 The product of Invention II and of Invention IV are not used in the method of Invention V or Invention VI. Therefore, Inventions II and IV are patentably distinct from Inventions V and VI.

The methods of Inventions V and VI require different products and steps and have different endpoints. Therefore, Inventions V and VI are patentably

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distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different 5 classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an 10 inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

15 Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is (703) 308-0034. The Examiner can normally be reached daily except alternate Fridays from 7:30 A.M. to 5:00 P.M.

20 If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Christopher Low, can be reached at (703) 308-2923. The OFFICIAL fax phone number for Technology Center 1600 is (703) 308-4242.

25 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

*Karen Cochrane Carlson Ph.D.*  
Karen Cochrane Carlson, Ph.D.  
Primary Examiner

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